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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,829	03/28/2001	Tatsuya Tamaru	P20837	1507

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EXAMINER

LETT, THOMAS J

ART UNIT PAPER NUMBER

2626

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/818,829	Applicant(s) TAMARU, TATSUYA	
	Examiner Thomas J. Lett	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-44 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 34,35,39,40,42 and 44 is/are allowed.
6) ☒ Claim(s) 28-33,36-38,41 and 43 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 28 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/28/01, 9/1/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Detailed Action</u> . |

DETAILED ACTION

Allowable Subject Matter

1. Claims 34, 35, 39, 40, 42, and 44 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: Claims 34, 39, 42, and 44 of the current application teach similar subject matter as the prior art of Shibata (USPN 6,825,955 B1). However, claims 34, 39, 42, and 44 are allowed for the reasons pointed out by Applicant's remarks (page 12, lines 16-21).

It follows that claims 35 and 40 are then inherently allowable for depending on an allowable base claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 36, 37, 41, and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Shibata (USPN 6,825,955 B1).

With respect to claim 36, Shibata discloses a receiving Internet facsimile apparatus (local facsimile apparatus 6, col. 5, lines 25-26) connected to a mail server

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(local internet server 7, see Fig. 1) via the Internet and receiving data from a transmitting Internet facsimile apparatus via a telephone network, the transmitting Internet facsimile apparatus (facsimile apparatus 1, col. 5, lines 24-25) transmitting, to the mail server via the Internet, an e-mail directed to the receiving Internet facsimile apparatus, the receiving Internet facsimile apparatus comprising:

a receiver (local facsimile apparatus 6) configured to receive a predetermined notice from the transmitting Internet facsimile apparatus (facsimile apparatus 1) via a telephone network, the predetermined notice indicating that the transmitting Internet facsimile apparatus has transmitted, to the mail server via the Internet, the e-mail directed to the receiving Internet facsimile apparatus, the predetermined notice further including information regarding a data file attached to the e-mail (E-mail service unit 16 instructs the third E-mail service unit 18 to start an E-mail transmission notifying operation so that an E-mail transmission notice is sent to the local facsimile apparatus 6, col. 8, lines 57-60); and

a controller (local facsimile apparatus 6) configured to access the mail server (local internet server 7, see Fig. 1) and to obtain the e-mail from the mail server (local internet server 7), based on the information regarding the data file included in the predetermined notice, when the predetermined notice is received from the transmitting Internet facsimile apparatus (communication terminal attempts to access and retrieve the e-mail including the attachment file of image data from the second service provider in response to receiving the notice, col. 4, lines 15-21).

With respect to claim 37, Shibata discloses a receiving Internet facsimile apparatus (local facsimile apparatus 6) according to claim 36, wherein the controller accesses the mail server, when it is determined that the receiving Internet facsimile apparatus can receive the e-mail, based on the information regarding the data file included in the predetermined notice (communication terminal attempts to access and retrieve the e-mail including the attachment file of image data from the second service provider in response to receiving the notice, col. 4, lines 15-21).

Claim 41, a transmitting method claim, is rejected for the same reason as that of claim 36.

Claim 43, a receiving method claim, is rejected for the same reason as that of claim 36.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 28-33, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata (USPN 6,825,955 B1) in view of Ishibashi et al (USPN 6,374,291 B1).

With respect to claim 28, Shibata discloses a transmitting Internet facsimile apparatus (facsimile apparatus 1, col. 5, lines 24-25) transmitting data to a receiving

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Internet facsimile apparatus (local facsimile apparatus 1, col. 5, lines 25-26) via a telephone network (public telephone network 2, col. 5, lines 27-29) and being connected to the Internet (Internet 3, col. 5, lines 15-19), the receiving Internet facsimile apparatus being connected to a mail server via the Internet (local facsimile apparatus 1, col. 5, lines 25-26, see Fig. 1), the mail server storing an e-mail directed to the receiving Internet facsimile apparatus, the receiving Internet facsimile apparatus accessing the mail server to obtain the e-mail directed to the receiving Internet facsimile apparatus, the transmitting Internet facsimile apparatus comprising:

a controller (main controller 10, which controls unit controllers 16-19) configured to transmit, to the mail server via the Internet, the e-mail directed to the receiving Internet facsimile apparatus (E-mail service unit 16 controls services for transmitting and receiving E-mail via the Internet using the communications protocols of SMTP and POP, col. 6, lines 51-57),

the controller being further configured to transmit a predetermined notice to the receiving Internet facsimile apparatus via the telephone network, the predetermined notice indicating that the transmitting Internet facsimile apparatus has transmitted the e-mail directed to the receiving Internet facsimile apparatus (E-mail service unit 16 instructs the third E-mail service unit 18 to start an E-mail transmission notifying operation so that an E-mail transmission notice is sent to the local facsimile apparatus 6, col. 8, lines 57-60).

Shibata does not expressly disclose that the predetermined notice further including information regarding a data file attached to the e-mail. Ishibashi et al teach of

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a transmission notification report (Fig. 11) showing an indication of number of pages, data type, and data volume.

Shibata and Ishibashi et al are analogous art because they are from the similar problem solving area of facsimile communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the more detailed notification feature of Ishibashi to the notice of Shibata in order to obtain a notice with more information about the data of an email message. The motivation for doing so would be to inform user of a transmitted email.

With respect to claim 29, Shibata does not expressly disclose that the information regarding the data file attached to the e-mail comprises one of a file format, a compression method, a number of colors of the data, a number of original documents, or an amount of the data. Ishibashi et al teach of a transmission notification report (Fig. 11) showing an indication of number of pages, data type, and data volume.

Shibata and Ishibashi et al are analogous art because they are from the similar problem solving area of facsimile communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the more detailed notification feature of Ishibashi to the notice of Shibata in order to obtain a notice with more information about the data of an email message. The motivation for doing so would be to inform user of a transmitted email.

With respect to claim 30, Shibata discloses a transmitting Internet facsimile apparatus according to claim 28, wherein the controller transmits the predetermined notice, using a control signal (AAA signal, see Fig. 12) utilized in a facsimile

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communication protocol (see Fig. 5, for signals used to transmit the notice and col. 9, lines 5-17).

With respect to claim 31, Shibata discloses a transmitting Internet facsimile apparatus according to claim 30, wherein the controller receives, from the receiving Internet facsimile apparatus, a response to the control signal, the response indicating that the receiving Internet facsimile apparatus has received the predetermined notice (E-mail transmission notice acknowledgment, between the facsimile apparatus 1 and the local facsimile apparatus 6, col. 14, lines 14-22).

With respect to claim 32, Shibata discloses a transmitting Internet facsimile apparatus according to claim 30, wherein the control signal comprises a nonstandard control signal utilized in a facsimile communication protocol new representations AAA and BBB are provided in which AAA represents the E-mail transmission notice to be sent from the calling party and BBB represents the E-mail transmission notice acknowledgment to be sent from the called party, col. 16, lines 15-19).

With respect to claim 33, Shibata discloses a transmitting Internet facsimile apparatus according to claim 28 wherein the controller transmits the predetermined notice as image data in a facsimile communication protocol (E-mail service unit 16 instructs the third E-mail service unit 18 to start an E-mail transmission notifying operation so that an E-mail transmission notice (i.e., the fax image of Table 1 in Fig. 6) is sent to the local facsimile apparatus 6, col. 8, lines 57-60).

With respect to claim 38, Shibata does not expressly disclose that the information regarding the data file included in the predetermined notice comprises one of a file

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format, a compression method, a number of colors of the data, a number of original documents, or an amount of the data. Ishibashi et al teach of a transmission notification report (Fig. 11) showing an indication of number of pages, data type, and data volume. Shibata and Ishibashi et al are analogous art because they are from the similar problem solving area of facsimile communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the more detailed notification feature of Ishibashi to the notice of Shibata in order to obtain a notice with more information about the data of an email message. The motivation for doing so would be to inform user of a transmitted email.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is (571)272-7464. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJL

(TJL)

KA Williams
KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER